

REMARKS

The following issues are outstanding in the pending application:

- Claims 1-4, 6-16, and 23 are rejected under 35 USC 103 over Hutchins, Cook and Yeagle;
- Claims 17-19 are rejected under 35 US 103 over Hutchins, Cook and Yeagle further in view of DE Patent No 20213719; and
- Claim 20 is rejected under 35 USC 103 over Hutchins, Cook, Yeagle further in view of the German patent.

I. Claim Amendments

Claims 1, 16 and 20 are amended to clarify that the engaging member projects outwardly from the wall of the tube portion and extends around the circumference of the tube or the adjusting member. Support for this amendment is found at least in Figures 8a and 8b of the application, elements 26a and 27a. Applicant asserts no new matter is entered.

II. Claim Rejections under 35 USC 103

A. 35 USC 103 rejection of claims 1-4, 6-16 and 23

Claims 1-4, 6-16 and 23 are rejected under 35 USC 103(a) as being unpatentable over US Patent No 2,266,043 (“Hutchins”), U.S. Patent No. 2,398,921 (“Cook”), and further in view of US Patent No 3, 595,269 (“Yeagle”). Applicants respectfully traverse.

Hutchins describes a portable device that is adapted to be positioned over the drain opening for controlling the flow of liquid into the drain. The device comprises a base portion 1 and a hollow column 2 which is frictionally attached to the base member 1 in a fluid-tight relation. The base portion 1 comprises a tubular portion 5 and a skirt portion 6 formed integrally therewith. The tubular portion 5 snugly receives the lower end of the column 2 to seal with the latter and frictionally retain it in any position of rotation into which it may be turned. The material of the base 1 is extended inwardly at the lower end of the tubular portion 5, to provide a flange 8, which limits downward movement of the column 2 in the

base portion to thereby facilitate the quick adjustment of the column in the base to bring the windows 3 and 7 at the same level. The skirt portion 6 of the base is of an over-all diameter sufficient to cover the usual strainer plate 12 in the drain opening of a sink so that it can lie there over and seal with the bottom of the sink surrounding the strainer plate 12. See Fig. 2. This skirt-portion 6 is preferably made very thin and flexible so that it readily conforms to the sink in response to slight pressure of water or other liquid retained in the sink. The device is positioned immediately over the strainer plate 12 and concentric relative thereto so that the skirt 6 overlaps the strainer plate 12 on all sides and prevents leakage of water thereunder.

Cook describes an adjustable overflow for use in bathtubs to safely fill the level from three to five inches above what is normally permitted by the usual overflow outlets. The base portion 10 of the overflow is secured over the conventional overflow outlet 12 on the side of a bathtub 14. See Fig. 2. A watertight joint must be provided where the base 10 contacts the surface of the tub 14. The overflow has a rotatable outside portion with openings that can be moved into and out of register with an interior wall with openings. Further openings are additionally provided on the top of the adjustable overflow to define a max level of fluid.

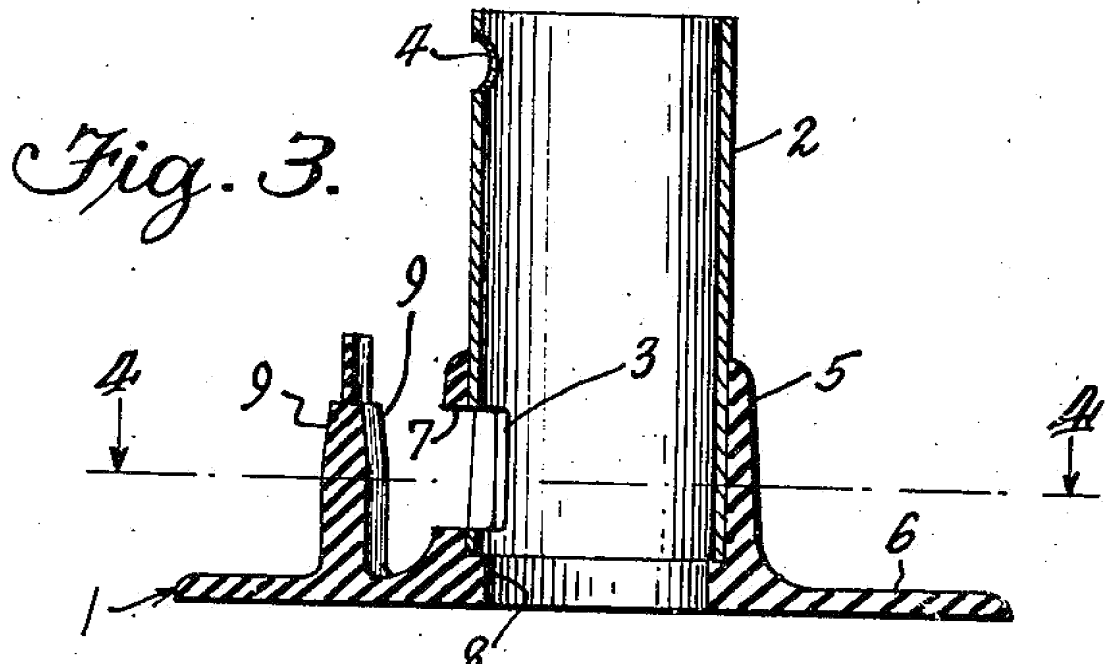
Yeagle is directed to a combined drain and overflow valve assembly adapted for upright mounting in the water reservoir of a humidifier. The drain/overflow valve assembly includes a hollow casing having a lateral inlet port and a hollow core rotatably mounted in the casing. The core has a longitudinal passage open at both upper and lower ends for overflow discharge. The humidifier has a tray bottom wall 27 with a noncircular aperture 28 through which the drain and overflow valve is placed such that a portion of the drain/overflow valve extends both above and below the tray bottom wall.

Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), controls the consideration and determination of obviousness under 35 U.S.C. 103(a); *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734-35, 167 L. Ed. 2d 705, 715 (U.S. 2007). The four factual inquires enunciated therein for determining obviousness are: (1) determining the scope and contents of the prior art; (2) ascertaining the differences between the prior art and the claims in issue; (3) resolving the level of ordinary skill in the pertinent art; and (4) evaluating evidence of secondary considerations.

In this case, neither the level of ordinary skill in the art, nor secondary considerations are at issue. However, in order to assess the scope and content of the prior art properly, a thorough understanding of the invention must be acquired by studying Applicant's claims and the specification. M.P.E.P. § 2141. Thus, the inquiry begins with construction of Applicant's claims, explained below. Next, when ascertaining the differences between the prior art and the claims at issue, both the invention and the prior art references as a whole must be considered, and *all* claim limitations must be considered when determining patentability of Applicant's invention. M.P.E.P. §§ 2141; 2143. When this is properly done in this case, as shown below, it becomes clear that differences exist that preclude obviousness. And finally, the test for obviousness requires identification of a reasonable basis for combining the claimed elements in the claimed fashion. *KSR*, 127 S. Ct. at 1741; M.P.E.P. §2143. As shown below, this requirement is not met in this case, and no *prima facie* case for obviousness is made.

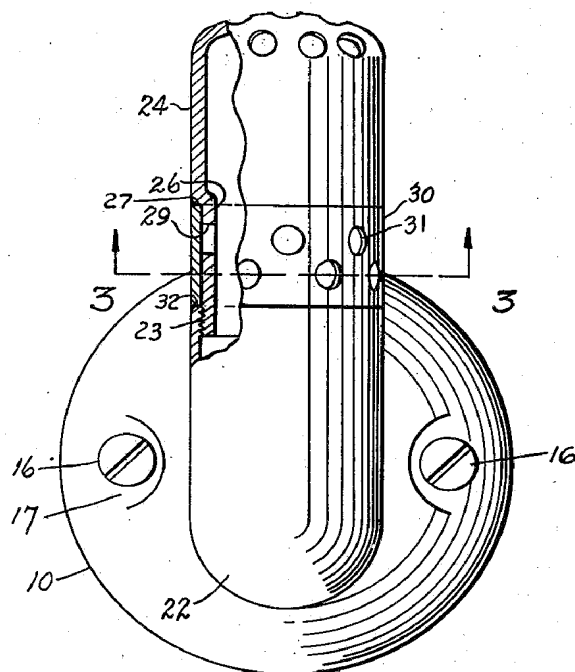
Applying the proper test to this case begins with amended independent claims 1, 16 and 20 that require at least a peripheral retaining groove for co-operating with an engagement member that projects outwardly from the wall of the tube portion and extends around the circumference of the tube portion or alternatively, the tube portion includes a peripheral retaining groove for co-operating with an engagement member that projects outwardly from the wall of the adjusting member and extends around the circumference of the adjusting member.

To account for a groove the Examiner cited Hutchins proximate 8 in figure 3, and Cook ("see grooves and engagement members allowing sliding fit of the components and threaded connections in items 23-31 in figure 1," Office Action, pg 4). To account for an engagement member the Examiner cited the bottom surface of 2 in Hutchins and the threaded connections in Cook. It appears from the Office Action and the Examiner Interview that the Examiner considers the shelf cut out of Figures 3 and 5 of Hutchins to be a "groove" and the bottom of a tube to be a "engagement member." While the Applicant does not agree with the claim interpretation, the Applicant herein amends the claim to specify that the engagement member projects outwardly from the wall and extends around the circumference. Hutchins does not disclose such a projection (see figure 3 below).



As can be seen from Fig. 3 of Hutchins above, there is no projection that extends around the circumference of the column 2 or the tubular portion 5.

Further, Cook at least does not account for the adjusting member including a peripheral retaining groove for co-operating with an engagement member that projects outwardly from the wall of the tube portion and extends around the circumference of the tube portion or alternatively, the tube portion includes a peripheral retaining groove for co-operating with an engagement member that projects outwardly from the wall of the adjusting member and extends around the circumference of the adjusting member. Figure 1 of Cook is given below.

Fig. 1

Within the figure, the tubular portion 24 is threaded (23) into the outwardly or horizontally extending portion 22 (Col. 2, ll. 24-27). The movable closure strip or ring 30 is then clamped together in an adjustable position between the tubular portion and the outwardly extending portion (Col. 2, ll. 27-30). Cook's closure ring, which the Examiner has used to account for the adjusting member in the claims, is freely rotatable around the tubular portion and does not appear to comprise an engagement member that projects outwardly from the wall of the tube portion and extends around the circumference for co-operating with a groove, nor does it appear to comprise a groove for co-operating with an engagement member. As such, Cook does not disclose at least this element of the claims.

As not all elements of the claims have been accounted for, there is no *prima facie* case of obviousness. Applicant respectfully requests withdrawal of the rejection.

B. 35 USC 103 rejection of claims 17-19

Claims 17-19 are rejected under 35 USC 103(a) as being unpatentable over Hutchins, Cook, Yeagle and further in view of DE Patent No 20213719 (the “German Patent”). Applicants respectfully traverse.

Applicant respectfully submits that the previous discussion of the patentability of the current invention over the cited references obviates this rejection. The German Patent adds no new teaching that would result in the inventive package of claim 16. Claims 17-19 depend at least in part on amended independent claim 16. If an independent claim is non-obvious under 35 U.S.C. 103, than any claim depending therefrom is by definition nonobvious. *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Applicant respectfully asserts that because of the dependency from 16, claims 17-19 are nonobvious over these references. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of claims 17-19 under 35 U.S.C. 103(a).

C. 35 USC 103 rejection of claim 20

Claim 20 is rejected under 35 USC 103(a) as being unpatentable over Hutchins in view of Cook and further in view of Yeagle and further in view of the German Patent. Applicants respectfully traverse.

Applicant respectfully submits that the previous discussion of the patentability of the current invention over the cited references obviates this rejection. No new teachings are described in the German Patent that would result in the inventive package of claim 20. Specifically, the cited art does not disclose a peripheral retaining groove for co-operating with an engagement member that projects outwardly from the wall of the tube portion and extends around the circumference of the tube portion or alternatively, the tube portion includes a peripheral retaining groove for co-operating with an engagement member that projects outwardly from the wall of the adjusting member and extends around the circumference of the adjusting member, as described above. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of claim 20 under 35 U.S.C. 103(a).

CONCLUSION

Other than the RCE fee, paid at the time of this submission, Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2375, under Order No. HO-P03260US0 from which the undersigned is authorized to draw.

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Respectfully submitted,

By___/TIFFANY WEKSBERG/_____
Tiffany Weksberg
Registration No.: 63,229
FULBRIGHT & JAWORSKI L.L.P.
Fulbright Tower
1301 McKinney, Suite 5100
Houston, Texas 77010-3095
(713) 651-5151
(713) 651-5246 (Fax)
Agent for Applicant